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| 10/086,288 | 03/01/2002 | Robert C. Mayes | 10014732-1 | 2038 |

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

WU, RUTAO

| | |
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| ART UNIT | PAPER NUMBER |
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3639

DATE MAILED: 02/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/086,288

Applicant(s)

MAYES ET AL.

Examiner

Rutao Wu

Art Unit

3639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on March 1, 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 19 and 20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 19 and 20 are written in "single means claim" format since they recite only one element to do all the functions recited. The claim is not written in "means-plus-function" language, however, in *Fiers v. Revel*, (CAFC) 25 USPQ2d 1601, 1606 (1/19/1993), the CAFC affirmed a rejection under 35

USC 112 of a claim reciting a single element that did not literally use “means-plus-function” language. Claims 19 and 120 are drawn to any “printing system” and “reading system”, regardless of construct, that performs the function recited. This parallels the fact situation in *Fiers* wherein “a DNA” and a result was recited. The CAFC stated in *Fiers* at 1606 “Claiming all DNA’s that achieve a result without defining what means will do so is not in compliance with the description requirement; it is an attempt to preempt the future before it has arrived”. See also *Ex parte Maizel*, (BdPatApp&Int) 27 USPQ2d 1662, 1665 and *Ex parte Kung*, (BdPatApp&Int) 17 USPQ2d 1545, 1547 (1/30/1989) where the claims at issue were rejected for being analogous to single means claims even though “means” was not literally used. Thus, claims 19 and 20 yield an “printing system” and “reading system” that achieves a result without defining what will do so.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01.

5. Claims 19 and 20 are directed to a printing system and a reading system respectively. However, no element(s) of the system are disclosed which distinguishes the systems from any other systems.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. As per claim 18, the claimed invention is directed to non-statutory subject matter.

Claim 18 is directed to monetary values and is deemed to be descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter. See MPEP 2106 (IV)(B)(1)

Where certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer. Such "descriptive material" is not a process, machine, manufacture or composition of matter. (Data consists of facts, which become information when they are seen in context and convey meaning to people. Computers process data without any understanding of what that data represents. Computer Dictionary 210 (Microsoft Press, 2d ed. 1994).)

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-5, 7-8, 10-15, 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat No. 6,865,558 to Pierce et al.

Referring to claim 1:

A delivery service, comprising:

A first mail system configured to receive a mail piece addressed to an entity and including postage indicia indicating an initial value, determine a cost for delivering the mail piece to the entity, modify the postage indicia to indicate a remaining value wherein the remaining value indicates the initial value reduced by the cost for delivering the mail piece, and transfer the mail piece; and (col 5: lines 48-51)

A second mail system configured to receive the postage indicia indicating the remaining value, process the postage indicia to determine the remaining value of the postage indicia, and indicate the remaining value of the postage indicia. (col 6: lines 4-7)

Referring to claims 2 and 12:

The delivery service of claim 1 wherein the second mail system is further configured to:

Modify the postage indicia indicating the remaining value to cancel the remaining value of the postage indicia. (col 5: lines 48-51)

Referring to claim 3:

The delivery service of claim 1, wherein the second mail system is further configured to:

Compensate the entity for the remaining value of the postage indicia. (col 5: lines 54-57)

Referring to claim 4:

The delivery service of claim 3 wherein the second mail system is further configured to:

Credit an account for the entity based on the remaining value of the postage indicia to compensate the entity. (col 5: lines 54-57)

Referring to claim 5:

The delivery service of claim 3 wherein the second mail system is further configured to:

Transfer funds to a bank account for the entity based on the remaining value of the postage indicia to compensate the entity. (col 5: lines 54-57)

Referring to claim 7:

The delivery service of claim 1 wherein the postage indicia includes anti-counterfeiting content. (col 7: lines 4-13)

Referring to claim 8:

The delivery service of claim 1 wherein the postage indicia comprises text printed on the mail piece. (FIG 4a, 4b; col 4: lines 42-63)

Referring to claim 10:

The delivery service of claim 1 wherein the second mail system comprises a user interface configured to display the remaining value of the postage indicia. (col 5: lines 43-47)

Referring to claim 11:

A method of operating a delivery service, the method comprising:

Receiving a mail piece addressed to an entity and including postage indicia indicating an initial value; (col 5: lines 19-40)

Determining a cost for delivery the mail piece to the entity; (col 5: lines 48-51)

Modifying the postage indicia to indicate a remaining value wherein the remaining value indicates the initial value reduced by the cost for delivery the mail piece; (col 5: lines 48-51)

Delivering the mail piece to the entity; and (col 5: lines 62-64)

Compensating the entity for the remaining value indicated by the postage indicia. (col 5: lines 4-7)

Referring to claim 13:

The method of claim 11 further comprising:

Receiving the postage indicia that indicates the remaining value from the entity prior to compensating the entity. (col 6: lines 4-7)

Referring to claim 14:

The method of claim 11 wherein compensating the entity comprises:

Crediting an account for the entity based on the remaining value of the postage indicia. (col 5: lines 54-57)

Referring to claim 15:

The method of claim 11 wherein compensating the entity comprises:

Transferring funds to a bank account for the entity based on the remaining value of the postage indicia. (col 5: lines 54-57)

Referring to claim 17:

The method of claim 11 wherein the postage indicia includes anti-counterfeiting content. (col 7: lines 4-13)

Referring to claim 18:

Postage indicia, comprising:

A first monetary value component designated as compensation for a delivery service; and (Fig 4a, 4b)

A second monetary value component designated for a funds transfer. (Fig 4a, 4b)

Referring to claim 19:

A printing system configured to print the postage indicia of claim 18. (col 5: lines 57-59)

Referring to claim 20:

A reading system configured to read the second monetary value component of the postage indicia of claim 18. (col 7: lines 4-13)

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10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 6, 9, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce et al in view of U.S. Pat No. 6,427,139 to Pierce.

As per claims 6 and 16, Pierce et al disclose the ability to transfer funds electronically from one account to another based on the remaining value of the postage indicia. (col 5: lines 54-56)

Pierce et al does not expressly disclose transferring cash based on the remaining value of the postage indicia.

Pierce discloses the ability to transfer by check, credited to credit card, electronically transferred to an account, or provided as a credit.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Pierce et al's invention can transfer funds by cash. The reason one would want to include the ability to transfer by cash is that all forms of transfers are accepted.

As per claim 9, Pierce et al does not disclose wherein the postage indicia comprises a barcode printed on the mail piece.

Pierce does disclose barcode printed on the mail piece. (Fig 1 and Fig 4)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Pierce et al's invention to include barcodes

on the mail piece. One would be motivated to perform such modification because barcode graphics also provide a useful format for employing digital signature cryptographic transformations to establish the authenticity of value messages.

Conclusion

12. Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

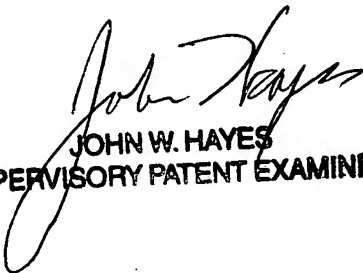
U.S. Pat No. 6,289,323 to Gordon et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rutao Wu whose telephone number is (571)272-3136. The examiner can normally be reached on Mon-Fri 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571)272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

rw


JOHN W. HAYES
SUPERVISORY PATENT EXAMINER